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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,028	03/16/2001	Donald J. Gjerdingen	1991-174	5691

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EXAMINER

WARDEN, JILL ALICE

ART UNIT PAPER NUMBER

1743

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/811,028

Applicant(s)

GJERDINGEN ET AL.

Examiner

Jill A. Warden

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: In order for the claimed invention to properly function as a dual rotary incubation station, it would appear that some additional elements need to be claimed. For each of the “spur gear means” to rotate the corresponding wheel, the gear drivers and the motors that move them need to be recited. Otherwise, the “spur gear means” recited will not operate to rotate anything. It is also noted that applicant claims an incubation station. Yet there is nothing recited in this station to distinguish it from a storage rack. The only elements recited as part of the incubation station are the wheels having nesting locations and gear teeth on the inner or outer periphery of the wheel, and a means to transfer vessels between the wheels. Without a means for rotating (the gear drivers) and some means for heating or cooling the vessels, it does not appear that applicant’s station can accurately be termed an “incubation” station.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakubowicz et al.

Jakubowicz et al teach a dual ring rotary incubator (50). Each ring (52, 54) has a plurality of nesting locations for cuvettes. Each ring is independently rotated by a gear-driven mechanism (66, 68). There is a moving means (200) for moving cuvettes between the rings. See figures 2-4 and the accompanying discussion, column 4, line 41, et seq.

Jakubowicz et al differ from the instantly claimed invention in the inclusion of 2 pick and place assemblies for transferring vessels between the rings instead of the single moving means, and the particular placement of the gears for driving the rings.

With respect to the use of pick and place assemblies instead of the pusher mechanism of Jakubowicz, such would have been obvious. A pick and place assembly

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would have permitted careful placement of cuvette without risking spilling of its contents. It would have been obvious to one having ordinary skill in the art to employ a pick and place cuvette transfer means in the apparatus of Jakubowicz in order to ensure movement of the cuvette without spilling of the contents. As to the use of two pick and place assemblies, it would have been obvious to employ two in order to provide one for movement from the outside to the inside ring and one for movement from the inside to the outside ring in order to avoid mechanical strain on the system by reciprocating movement.

With respect to placement of the gear teeth and gears, Jakubowicz teaches one gear and gear teeth on the inside of the inner ring and one gear and gear teeth on the outside of the outer ring. Applicant claims one gear and gear teeth on the inside of the outer ring and one gear and gear teeth on the outside of the inner ring. It would have been obvious to one having ordinary skill in the art to modify the gear placement in the apparatus of Jakubowicz to place the gears and gear teeth between the rings in order to make the apparatus more compact and protect the gears from outside influence.

With respect to the use of bearings for positioning the rings on the platform, Jakubowicz et al. are silent. However, bearings are a conventional means employed to provide rotational movement. It would have been obvious to one having ordinary skill in the art to employ bearings in the apparatus of Jakubowicz to permit rotation of the rings on their support surface.

With respect to the actuator for the gears, applicants recite a stepper motor. Jakubowicz et al. are silent as to their actuator. However, stepper motors are

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conventionally employed in rotating automatic analyzers. It would have been obvious to one having ordinary skill in the art to employ a stepper motor to rotate the rings in the apparatus of Jakubowicz et al. in order to provide regular rotation with stopping to provide access to each cuvette.

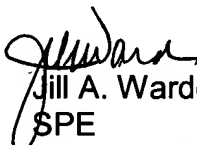
### ***Response to Arguments***

Applicant's arguments, filed 4/19/06, with respect to the rejection(s) of claim(s) 1-24 under 35 USC 103 over Tersteeg in view of Minekane have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Jakubowicz et al.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Also cited is Shaw, et al., a dual ring rotary analyzer driven by gears (see figure 3).

Any inquiry concerning this communication should be directed to Jill A. Warden at telephone number (571) 272-1267.

  
Jill A. Warden  
SPE  
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